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09/830,982	07/05/2001	Oded Kafri	P-2033-US	7273

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EXAMINER

HOOSAIN, ALLAN

ART UNIT PAPER NUMBER

2645

DATE MAILED: 03/09/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

SPM

# Office Action Summary

Application No.

09/830,982

Applicant(s)

KAFRI, ODED

Examiner

Allan Hoosain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 6-7, 9-10, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bartholomew et al.** (US 6,215,858).

As to Claim 1, with respect to Figures 10 and 13, **Bartholomew** teaches a method for forwarding a telephone call comprising the steps of:

routing the incoming telephone call to an IP (dedicated server) (Col. 37, lines 27-34),  
said server being associated with an unified messaging system configured to receive voice messages from any one of a group of telephone signaling protocols associated with a PSTN or PBX (Col. 37, lines 30-38);

identifying the number being dialed (Col. 37, lines 45-51);

associating at least one email address with said dialed number (Col. 37, lines 45-51);

digitizing the voice message (Col. 38, lines 1-20); and

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forwarding the digitized voice message as an encapsulation (attachment) to an email message to said at least one email address via the Internet (Col. 28, lines 40-45, 54-67 and Col. 29, lines 1-6),

As to Claims 3, 6, **Bartholomew** teaches a method according to claim 1, and further comprising the steps of:

storing said voice message in a voice box (Col. 38, lines 11-20); and

the recipient retrieving said voice message by telephone (Col. 38, lines 11-20).

As to Claim 4, with respect to Figures 10 and 13, **Bartholomew** teaches a method for forwarding a telephone call in email message format to a recipient, the method comprising the steps of:

the caller dialing a telephone number associated with an IP (dedicated server) (Col. 37, lines 27-34),

said server being associated with an unified messaging system configured to receive voice messages from any one of a group of telephone signaling protocols associated with a PSTN or PBX (Col. 37, lines 30-38);

identifying the telephone number of the caller (Col. 37, lines 27-32);

the caller entering the telephone number of the recipient of the telephone call (Col. 37, lines 47-51);

associating at least one email address with the telephone number of the recipient (Col. 37, lines 47-51);

digitizing the voice message (Col. 38, lines 1-20); and

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forwarding the digitized voice message as an encapsulation (attachment) to an email message to said at least one email address via the Internet (Col. 28, lines 40-45, 54-67 and Col. 29, lines 1-6).

As to Claims 7, 9, **Bartholomew** teaches a method according to claim 4, and further comprising the step of:

verifying whether the caller's telephone number matches the registered telephone number of the caller (Col. 37, lines 27-34).

As to Claims 10 and 12, 14, with respect to Figures 10 and 13, **Bartholomew** teaches a method for forwarding a facsimile message in email message format to a recipient, the method comprising the steps of:

the caller dialing a facsimile number associated with an IP (dedicated server) (Col. 37, lines 27-34 and Col. 39, lines 55-64),

said server being associated with an unified messaging system configured to receive voice messages from any one of a group of telephone signaling protocols associated with a PSTN or PBX (Col. 37, lines 30-38);

identifying the telephone number of the caller (Col. 37, lines 27-34);

the caller entering the facsimile number of the recipient of the facsimile (Col. 37, lines 45-51 and Col. 38, lines 58-60);

associating at least one email address with the facsimile number of the recipient (Col. 37, lines 47-51 and Col. 40, lines 1-4);

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converting the facsimile message into a format compatible with email (Col. 40, lines 5-9); and

forwarding the converted facsimile message as an attachment to an email message to said at least one email address via the Internet (Col. 39, line 55 through Col. 40, line 25).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2,5,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bartholomew** in view of **Bobo, II** (US 5,675,507).

As to Claims 2,5, **Bartholomew** teaches a method according to claim 1 wherein said step of forwarding comprises the steps of:

digitizing the voice message;

**Bartholomew** does not teach the following limitation:

“into a wav file”

**Bobo, II** teaches delivering voice messages in wav formats (Col. 13, lines 1-14). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add wav file capability to **Bartholomew's** invention for voice message delivery

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instructions as taught by **Bobo, II**'s invention in order to provide message delivery in particular formats.

As to Claim 11, **Bobo, II** teaches a method according to claim 10, wherein said step of forwarding comprises the steps of:

**Bartholomew** does not teach the following limitation:

“converting the facsimile message into a TIF file”

**Bobo, II** teaches delivering facsimile messages in TIF formats (Figure 6). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add TIF file capability to **Bartholomew**'s invention for facsimile message delivery as taught by **Bobo, II**'s invention in order to provide message delivery in particular formats.

5. Claims 8,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bartholomew** in view of **Hyde-Thomson** (US 5,557,659).

As to Claims 8,13, **Bartholomew** teaches a method according to claim 7, and if the identified telephone number does not match the registered telephone number of the caller, further comprising the step of:

**Bartholomew** does not teach the following limitation:

“only forwarding the voice message if a correct password and the registered telephone number associated with the caller is verified”

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**Hyde-Thomson** teaches password verification of callers (Figure 14, label 1406). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add password capability to **Bartholomew's** invention for recognizing callers as taught by **Hyde-Thomson's** invention in order to provide desired services to callers.

### *Response to Arguments*

1. Applicant's arguments filed in the 1/6/04 Remarks have been fully considered but they are not persuasive because of the following:

(a) With respect to Claims 1,4,10, **Bartholomew** does not teach any one of the signaling protocols associated with the PSTN.

Examiner respectfully disagrees. This is because the IP receives voice messages using ISDN protocols (Figure 13, Label ISDN). The argument appears to suggest that **Bartholomew** is limited to SS7 protocols and the invention can be used with PBX, SIP and PRI protocols. As seen in Figure 13, SS7 is only one protocol used for routing calls to the IP. The Claims do not recite PSTN and PBX and thus are limited to a PSTN or PBX.

(b) **Bartholomew** does not teach forwarding a voice message as an attachment to an e-mail address.

Examiner respectfully disagrees. This is because **Bartholomew** teaches that voice messages are encapsulated (attached) and transferred to destination internet addresses (e-mail format) (Col. 28, lines 54-65).

(c) **Bartholomew** does not teach routing an incoming facsimile call to a server and forwarding a facsimile message as an e-mail message.



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Examiner respectfully disagrees. This is because the cited passages teach forwarding facsimile calls to the IP and sending facsimile messages over the Internet (see the cited passages in the instant Office Action for Claim 10).

(c) Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Bergman et al.** (US 2003/0128691) teach a call server which routes e-mails with voice attachments to subscribers.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)

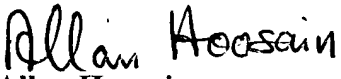
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**Allan Hoosain**  
**Primary Examiner**  
**2/5/04**